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**RE:** Application No. 10/629,373  
In re application of: Quock Ying Ng, et al.  
Assignee: SEAGATE TECHNOLOGY LLC  
Dkt. No.: STL11231

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PATENT  
Dkt. STL11231

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Quock Ying Ng, Yiren Hong, JingShi Goh, Niroot Jierapipatanakul, and  
Djohni Chandra  
Assignee: SEAGATE TECHNOLOGY LLC  
Application No.: 10/629,373 Group No.: 2653  
Filed: July 29, 2003 Examiner: Allen J. Heinz  
For: INTEGRATED FILTER SYSTEM FOR A DATA STORAGE DEVICE

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF  
(PATENT APPLICATION-37 C.F.R. § 41.37)

1. Transmitted herewith, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on January 19, 2006 and the Notice of Panel Decision from Pre-Appeal Brief Review mailed from the U.S. Patent Office on March 9, 2006

## 2. STATUS OF APPLICANT

This application is on behalf of other than a small entity.

## 3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

other than a small entity	\$500.00
<b>Appeal Brief fee due</b>	<b>\$500.00</b>

## CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a)

I hereby certify that, on the date shown below, this correspondence is being:

## TRANSMISSION

☒ facsimile transmitted to the Patent and Trademark Office, (571) 273 - 8300.

  
Signature

Date: April 7, 2006

Diana C. Anderson

(type or print name of person certifying)

## 4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

## 5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee	\$500.00
<b>TOTAL FEE DUE</b>	<b>\$500.00</b>

## 6. FEE PAYMENT

Authorization is hereby made to charge the amount of \$500.00 to Credit card as shown on the attached credit card information authorization form PTO-2038.

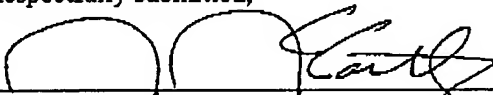
## 7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 06-0540.

Date:

4/7/2006

Respectfully submitted,



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CENTRAL FAX CENTER****APR 07 2006****PATENT****Dkt. STL11231**

Transmission by Facsimile on April 7, 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re Application of: **Quock Ying Ng, Yiren Hong, JingShi Goh, Niroot  
Jierapipatanakul and Djohni Chandra**Assignee: **SEAGATE TECHNOLOGY LLC**Application No.: **10/629,373**Group Art: **2653**Filed: **July 29, 2003**Examiner: **Allen J. Heinz**For: **INTEGRATED FILTER SYSTEM FOR A DATA STORAGE DEVICE**Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450**ATTENTION: Board of Patent Appeals and Interferences**

Sir:

**APPELLANT'S BRIEF**

This Brief is in furtherance of the Notice of Appeal that was filed in this case on January 19, 2006 and Notice of Panel Decision from Pre-Appeal Brief Review mailed from the U.S. Patent Office on March 9, 2006. The required fees, any required petition for extension of time for filing this Brief, and the authority and time limits established by the Notice of Appeal are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a)**

I hereby certify that, on the date shown below, this correspondence is being:

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SignatureDate: April 7, 2006Diana C. Anderson  
(type or print name of person certifying)

This brief contains these items under the following headings, and in the order set forth below:

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT
- VIII. CLAIMS APPENDIX
- IX. EVIDENCE APPENDIX
- X. RELATED PROCEEDINGS APPENDIX

### **I. REAL PARTY IN INTEREST**

The real party in interest in this Appeal is the party named in the caption of this brief.

### **II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this Appeal.

### **III. STATUS OF CLAIMS**

The status of the claims in this application is:

<u>Claim</u>	<u>Status</u>
1. (Previously presented)	Independent.
2. (Previously presented)	Depends from claim 1.
3. (Previously presented)	Depends from claim 2.
4. (Previously presented)	Depends from claim 3.
5. (Previously presented)	Depends from claim 1.
6. (Previously presented)	Depends from claim 1.
7. (Previously presented)	Depends from claim 6.
8. (Previously presented)	Depends from claim 7.
9. (Previously presented)	Depends from claim 7.
10. (Previously presented)	Depends from claim 9.
11. (Previously presented)	Depends from claim 9.
12. (Previously presented)	Depends from claim 7.
13. (Previously presented)	Depends from claim 12.
14. (Canceled)	

15. (Canceled)	
16. (Canceled)	
17. (Canceled)	
18. (Canceled)	
19. (Canceled)	
20. (Original)	Independent.
21. (Canceled)	
22. (Previously presented)	Independent.
23. (Previously presented)	Depends from claim 22.
24. (Previously presented)	Depends from claim 23.
25. (Previously presented)	Depends from claim 24.
26. (Previously presented)	Depends from claim 25.
27. (Previously presented)	Depends from claim 22.

#### A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application: 1-13, 20, and 22-27

#### B. STATUS OF ALL THE CLAIMS

1. Claims canceled: 14-19
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-13, 20, and 22-27
4. Claims allowed: none
5. Claims rejected: 1-13, 20, and 22-27
6. Claims objected to: none

#### C. CLAIMS ON APPEAL

Claims now on appeal: 1-13, 20, and 22-27

### IV. STATUS OF AMENDMENTS

Applicant filed a Pre-Appeal Brief Request for Review on January 19, 2006, but the Panel did not withdraw the final rejection.

### V. SUMMARY OF CLAIMED SUBJECT MATTER

The embodiments of the present invention as recited by the language of independent claim 1 contemplate a filter 136 with a channel 158 that guides a portion 176 of an internal

fluid stream (“As the disc 110 (of FIG. 1) rotates, air flows from the inner diameter to the outer diameter of the disc 110....” see para. [0038-0042]) within an enclosure 102, 104 (see para. [0048]). The portion flows through a recirculating filter 138 and a filter chamber 160 disposed immediately downstream of the recirculating filter. The filter chamber is capable of filtering an external fluid stream (“An airflow passing through the diffusion aperture 156...” see para. [0046-0047]) through a diffusion path 154.

The embodiments of the present invention as recited by the language of the claims depending from claim 1 contemplate a filter 174 that can be disposed outside the channel, capable of filtering the internal fluid stream portion that does not enter the channel (“air flow developed by rotation of the disc 110 that fails to enter the re-circulating filter channel 158....” see para. [0040]) The filter outside the channel can be supported by a portion 162 forming the filter chamber. The filter outside the channel can define a shroud in close mating relationship with the rotating disc (for example, para. [0035] and para. [0040]). The channel can also support a carpet filter 172.

FIG. 8 best shows the channel is sized to fluidly communicate with a first area of an upstream side of the recirculating filter, and the filter apparatus is sized to fluidly communicate with a second area of a downstream side of the recirculating filter that is greater than the first area. This arrangement imparts a relatively reduced pressure region in the fluid stream portion downstream of the recirculating filter. The diffusion path has a breather aperture 140 on an external side of the enclosure and a diffusion aperture 156 on an internal side of the enclosure. FIG. 8 best shows the diffusion aperture is disposed in the relatively reduced pressure region downstream of the recirculating filter. FIG. 5 shows a

breather filter 170 covering the breather aperture that is capable of intercepting fluid flowing through the diffusion path.

In these embodiments the breather filter is supported by the base portion 102 of the enclosure. FIG. 10 best shows embodiments whereby the filter chamber, which is a permeable enclosure around the diffusion aperture via aperture 168, supports the breather filter 170. Adsorbent filter materials such as carbon-based media (see para. [0043] and para. [0050]) and electrostatic media (see para. [0038]) are contemplated.

The embodiments of the present invention as recited by the language of independent claim 20 contemplate a data storage device 100 with a base deck 102 and a disc stack assembly 114 secured to the base deck. An actuator assembly 116 is adjacent the disc stack assembly and affixed to the base deck. A top cover 104 is attached to the base deck enclosing the disc stack assembly and the actuator assembly within a confined environment. The data storage device further has a *means for filtering* contaminants from the confined environment. The meaning of the *means for filtering* is ascertained in accordance with 35 U.S.C. §112, sixth paragraph. The Applicant has identified the function associated with the recited *means for filtering* element as being the efficient filtering of both internal and external particulates and chemical contaminants within the data storage device. (see Applicant's Response of 12/19/05, pg. 13; Applicant's Response of 8/8/05, pg. 15) The disclosed structure for performing the recited function includes the channel for guiding a portion of the internal fluid stream through the recirculating filter, and the filter chamber immediately downstream of the recirculating filter through which the external fluid stream flows through the breather and/or absorption filter(s).



The embodiments of the present invention as recited by the language of claim 22 contemplates a method including rotating a data storage medium inside an enclosure to create an internal fluid stream (see para. [0038]); diverting a portion of the internal fluid stream through a recirculating filter (see para. [0042]); and fluidly mixing the internal fluid stream portion and the external fluid stream with the filter chamber disposed within the internal fluid stream immediately downstream of the recirculating filter (see, for example, FIG. 8)

The diverting step is characterized by providing the channel 158 with a proximal end in fluid communication with the internal fluid stream and a distal end in fluid communication with a first area of an upstream side of the recirculating filter (for example, FIG. 8) The mixing step is characterized by enclosing the recirculating filter with a second area on a downstream side of the recirculating filter in order to induce a pressure drop in the internal fluid stream across the recirculating filter. (for example, FIG. 8) The mixing step is also characterized by filtering the external fluid stream. (for example, para. [0026]) The diverting and mixing steps are characterized by adsorbing contaminants from the fluid streams by the use of carbon-based and/or electrostatic filter media. (for example, para. [0038] and para. [0043]) The method also can filter a non-diverted portion of the internal fluid stream, such as by filter 174.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1-13 and 22-27 stand rejected under 35 USC 112, first paragraph, as not being enabled by the specification.
2. Claim 20 stands rejected under 35 USC 102(e) as being anticipated by Tuma '498.

## VII. ARGUMENT

### THE ENABLEMENT REJECTION FOR *EXTERNAL FLUID STREAM* IN INDEPENDENT CLAIMS 1 AND 22 IS CLEAR ERROR FOR BEING WHOLLY UNSUBSTANTIATED

The Examiner's stated basis for making the rejection of claims 1 and 22 final is that the claim term *external fluid stream* is undefined in the specification. (Office Action of 10/19/2005, pg. 2)

Applicant has repeatedly argued that the skilled artisan readily understands that *external fluid stream* means the fluid stream that originates externally to the disc drive enclosure. (see Applicant's Response of 8/8/2005, pg. 13; Applicant's Response of 12/19/2005, pg. 8; Applicant's Pre-Appeal Brief Request for Review filed 1/19/2006, pg.3) The Examiner's perfunctory reasoning for the rejection, followed by the Examiner's reticent lack of any response whatsoever to Applicant's rebuttals, now places Applicant in the inequitable position of having to draft this Brief in argument against an unsubstantiated rejection. Particularly, Applicant reiterates now that it is forced to speculate as to whether the Examiner's rejection is based on one or more of the terms "external" or "fluid" or "stream" being allegedly undefined, or whether it is based on the phrase "external fluid stream" being allegedly undefined.

The correct standard for applying the enablement requirement is that the specification must teach those skilled in the art how to make and use the claimed invention without undue experimentation. *In re Wright*, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Applicant will now address each of the speculated bases for the rejection against this standard in turn.

The term "external" is used in the context of "to filter particulate contaminants from an environment external to the data storage device" (para. [0008]) no less than thirteen times

in the specification. (Abstract, [0004], [0008], [0026], [0030], [0032-0033], [0041], [0046], [0047]) The data storage device 100 is described as having a base 102 and a cover 104 forming a sealed housing (para. [0022]). The skilled artisan readily understands “external” as plainly meaning being outside the sealed housing. The enablement requirement is satisfied because the skilled artisan would understand, given the meaning of “external,” how to make and use the claimed invention without undue experimentation.

The term “fluid” is supported by the use of the terms “air” or “airstream” in the context of “an air stream migrating through the breather diffusion path 154” (para. [0037]) no less than thirteen times in the specification. (Abstract, para. [0003], [0026], [0037], [0041], [0046], [0047]) The term “fluid” is also supported by the use of “non-air” terms such as gases, vapors, contaminants, aerosols, particulates, chemicals, volatiles, humidity, particles, and the like, in the context of being entrained in the present atmosphere, no less than forty-eight times in the specification. (Abstract, para. [0001], [0003-0004], [0006], [0008-0009], [0026], [0032], [0033], [0037-0038], [0039-0041], [0043], [0045-0047], [0050-0051]) The skilled artisan readily understands “fluid” as plainly meaning the constituency of the present atmosphere, either external or internal to the enclosure. The enablement requirement is satisfied because the skilled artisan would understand, given the meaning of “fluid,” how to make and use the claimed invention without undue experimentation.

The term “stream” is used in the context of being a fluid with a velocity no less than eight times in the specification. (Abstract, para. [0037], [0042-0045]) The “external stream” is drawn into the enclosure via the diffusion path 154. (for example, para. [0030]) The “internal stream” is created by the spinning discs. (for example, para. [0038]) The skilled

artisan readily understands “stream” as plainly meaning a velocity vector imparted to the fluid. The enablement requirement is satisfied because the skilled artisan would understand, given the meaning of “stream,” how to make and use the claimed invention without undue experimentation.

If the Examiner’s rejection is based on the specification not explicitly using the term “external fluid stream,” then it has no basis in the law. The specification need not describe the invention *in haec verba*. That is, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the filing date the applicant had invented what is now claimed.” *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995). See also *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779 (Fed. Cir. 2002) (“[T]he failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.”). The test for sufficiency of support is whether the disclosure of the application reasonably conveys to the skilled artisan that the inventor had possession at that time of the later claimed matter. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991). The Examiner is thus obligated to measure the support found in the specification according to the understanding of one of ordinary skill in the art. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313 (Fed. Cir. 2003). For the reasons discussed above, the skilled artisan would readily understand the meaning of the terms “external,” “fluid,” and “stream” individually, and when grouped together the collective meaning is even clearer.

The Examiner has provided no substantiation for the alleged lack of enablement, and has not responded to Applicant's repeated rebuttals. For the reasons discussed above, the specification clearly enables a skilled artisan to make and use the invention as claimed without undue experimentation. Accordingly, it is the Applicant's position that in view of these facts illuminated by the law, equity deems the enablement rejection for *external fluid stream* to be erroneous as a matter of law and as such the rejection of claims 1 and 22 and the claims depending therefrom should be reversed.

THE ENABLEMENT REJECTION FOR *INTERNAL FLUID STREAM* IN INDEPENDENT CLAIMS 1 AND 22 IS CLEAR ERROR FOR BEING WHOLLY UNSUBSTANTIATED

The Examiner's stated basis for making the rejection of claims 1 and 22 final is also that the claim term *internal fluid stream* is undefined in the specification. (Office Action of 10/19/2005, pg. 2)

Applicant has repeatedly argued that the skilled artisan readily understands the *internal fluid stream* means the fluid stream that originates internally to the disc drive enclosure. (see Applicant's Response of 8/8/2005, pg. 13; Applicant's Response of 12/19/2005, pg. 8; Applicant's Pre-Appeal Brief Request for Review filed 1/19/2006, pg.3) The Examiner's perfunctory reasoning for the rejection, followed by the Examiner's reticent lack of any response whatsoever to Applicant's rebuttals, now places Applicant in the inequitable position of having to draft this Brief in argument against an unsubstantiated rejection. Particularly, Applicant reiterates now that it is forced to speculate as to whether the Examiner's rejection is based on one or more of the terms "internal" or "fluid" or "stream" being allegedly undefined, or whether it is based on the phrase "internal fluid stream" being allegedly undefined.

The correct standard for applying the enablement requirement is that the specification must teach those skilled in the art how to make and use the claimed invention without undue experimentation. *In re Wright*, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Applicant will now address each of the speculated bases for the rejection against this standard in turn.

The term “internal” is used in the context of “contaminating the internal environment of the head-disc assembly 106” (para. [0047]) no less than nine times in the specification. (Abstract, [0001], [0011], [0032], [0046], [0047]) The data storage device 100 is described as having a base 102 and a cover 104 forming a sealed housing (para. [0022]). The skilled artisan readily understands “internal” as plainly meaning being inside the sealed housing. The enablement requirement is satisfied because the skilled artisan would understand, given the meaning of “internal,” how to make and use the claimed invention without undue experimentation.

Reiterating, the term “fluid” is supported by the use of the terms “air” or “airstream” in the context of “an air stream migrating through the breather diffusion path 154” (para. [0037]) no less than thirteen times in the specification. (Abstract, para. [0003], [0026], [0037], [0041], [0046], [0047]) The term “fluid” is also supported by the use of “non-air” terms such as gases, vapors, contaminants, aerosols, particulates, chemicals, volatiles, humidity, particles, and the like, in the context of being entrained in the present atmosphere, no less than forty-eight times in the specification. (Abstract, para. [0001], [0003-0004], [0006], [0008-0009], [0026], [0032], [0033], [0037-0038], [0039-0041], [0043], [0045-0047], [0050-0051]) The skilled artisan readily understands “fluid” as plainly meaning the constituency of the present atmosphere, either external or internal to the enclosure. The enablement requirement is satisfied because the skilled artisan would understand, given the

meaning of “fluid,” how to make and use the claimed invention without undue experimentation.

Reiterating, the term “stream” is used in the context of being a fluid with a velocity no less than eight times in the specification. (Abstract, para. [0037], [0042-0045]) The “external stream” is drawn into the enclosure via the diffusion path 154. (for example, para. [0030]) The “internal stream” is created by the spinning discs. (for example, para. [0038]) The skilled artisan readily understands “stream” as plainly meaning a velocity vector imparted to the present environment. The enablement requirement is satisfied because the skilled artisan would understand, given the meaning of “stream,” how to make and use the claimed invention without undue experimentation.

If the Examiner’s rejection is based on the specification not explicitly using the term “internal fluid stream,” then it has no basis in the law. The specification need not describe the invention *in haec verba*. That is, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the filing date the applicant had invented what is now claimed.” *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995). See also *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779 (Fed. Cir. 2002)(“[T]he failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.”). The test for sufficiency of support is whether the disclosure of the application reasonably conveys to the skilled artisan that the inventor had possession at that time of the later claimed matter. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991). The Examiner is thus obligated to

measure the support found in the specification according to the understanding of one of ordinary skill in the art. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313 (Fed. Cir. 2003). For the reasons discussed above, the skilled artisan would readily understand the meaning of the terms “internal,” “fluid,” and “stream” individually, and when grouped together the collective meaning is even clearer.

The Examiner has provided no substantiation for the alleged lack of enablement, and has not responded to Applicant’s repeated rebuttals. For the reasons discussed above, the specification clearly enables a skilled artisan to make and use the invention as claimed without undue experimentation. Accordingly, it is the Applicant’s position that in view of these facts illuminated by the law, equity deems the enablement rejection for *internal fluid stream* to be erroneous as a matter of law and as such the rejection of claims 1 and 22 and the claims depending therefrom should be reversed.

THE ANTICIPATORY REJECTION OVER TUMA ‘498 FOR THE *MEANS FOR FILTERING* OF INDEPENDENT CLAIM 20 IS CLEAR ERROR FOR BEING WHOLLY UNSUBSTANTIATED

Applicant reiterates its previous traversals of this rejection (see Applicant’s Response of 8/8/2005, ppg. 15-16; Applicant’s Response of 12/19/2005, ppg. 11-13, Applicant’s Response of 1/19/2006, pg. 4) because the Examiner’s stated basis is unsubstantiated. In maintaining the anticipatory rejection the Examiner stated the following:

While applicant’s arguments pursuant to *In re Donaldson* are germane, applicant has neither set for [sic] arguments that the means is not a mere obvious mode of “filtering” and /or claim limitations that would support the contention that the instantly claim [sic] “filtering means” differentiate over know [sic] and therefore obvious means of filtering.  
(Office Action of 10/19/2005, pg. 4)



Applicant reiterates that the Examiner has apparently agreed that claim 20 comes under Section 112 paragraph six but refuses to construe it accordingly. (see Applicant's Response of 1/19/2006, pg. 4)

More particularly, Applicant again reiterates, in order to clarify, that in order to substantiate an anticipatory rejection of this means-plus-function claim the Examiner is obliged as a matter of law to construe this means element as the disclosed structure, and equivalents thereof, that are capable of the identical recited function. (see Applicant's Response of 8/8/2005, pg. 15; Applicant's Response of 12/19/2005, pg. 12) In view of this standard, it is unclear what the Examiner means by "obvious mode of filtering" and "differentiate over know [sic] and therefore obvious means of filtering." (Office Action of 10/19/2005 pg. 4)

Contrary to the Examiner's comments, Applicant has set forth express arguments in the record as to why a proper claim construction for claim 20 would not read on Tuma '498:

As discussed above, the present embodiments disclose structure that contemplates placing the filter chamber filtering the external fluid stream within the internal fluid stream. Contrarily, Tuma '498 isolates the filter chamber from the internal fluid stream, requiring a relatively more complicated and larger structure to impart a negative pressure from the internal fluid stream to the filter chamber. Also as discussed, the structure of the present embodiments provides a two-stage filtering of the internal fluid stream, as opposed to the single-stage filtering of Tuma '498. Clearly, the structures of the present embodiments and Tuma '498 operate in different ways, and are thus not structural equivalents, making Tuma '498 beyond the contemplated scope claim 20. When this means element is properly construed, it is clear that Tuma '498, taken as a whole, fails to disclose any equivalent structure in relation to the embodiments of the present invention as claimed.

Reconsideration and withdrawal of the present rejection of claim 20 and the claims depending therefrom are respectfully requested.

(Applicant's Response of 8/8/2005, pg. 16, emphasis added)

Reiterating, the disclosed structure of the present embodiments places the filter chamber within the internal fluid stream immediately downstream of the recirculating filter. This structural arrangement makes possible the smaller footprint and dual-stage filtering of the present embodiments in comparison to Tuma '498. Accordingly, the structure of Tuma '498 is not equivalent in accordance with a proper means-plus-function claim construction under Section 112 paragraph 6.


Applicant reiterates that the Examiner has failed to substantiate a prima facie case of anticipation because Tuma '498 does not identically disclose all the features of the present embodiments as claimed in claim 20. The Examiner has provided no substantiation for the alleged anticipatory rejection, and has not responded to Applicant's repeated rebuttals. Accordingly, it is the Applicant's position that in view of these facts illuminated by the law, equity deems the anticipatory rejection of claim 20 to be erroneous as a matter of law and as such the rejection of claim 20 and the claims depending therefrom should be reversed.

Conclusion

In conclusion, Applicant respectfully submits that the Examiner has not substantiated either the enablement or the anticipatory rejections of the pending claims. Accordingly, the Applicant respectfully requests that the rejection of all pending claims be reversed.

Respectfully submitted,

By:



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### VIII. CLAIMS APPENDIX

1. (Previously presented) A filter apparatus comprising a channel capable of guiding a portion of an internal fluid stream within an enclosure through a recirculating filter and a filter chamber disposed in the internal fluid stream portion immediately downstream of the recirculating filter, the filter chamber capable of filtering an external fluid stream through a diffusion path.

2. (Previously presented) The filter apparatus of claim 1, further comprising a filter disposed outside the channel capable of filtering the internal fluid stream portion not entering the channel.

3. (Previously presented) The filter apparatus of claim 2 wherein the filter disposed outside the channel is supported by the filter chamber.

4. (Previously presented) The filter apparatus of claim 3 wherein the filter disposed outside the channel defines a shroud in close mating relationship with a moving member that creates the internal fluid stream.

5. (Previously presented) The filter apparatus of claim 1 wherein the channel supports a carpet filter.

6. (Previously presented) The filter apparatus of claim 1 wherein the channel is sized to fluidly communicate with a first area of an upstream side of the recirculating filter, and the filter apparatus is sized to fluidly communicate with a second area of a downstream side of the recirculating filter, wherein the second area is substantially greater than the first area to impart a relatively reduced pressure region in the fluid stream portion downstream of the recirculating filter.

7. (Previously presented) The filter apparatus of claim 6 wherein the diffusion path comprises a breather aperture on an external side of the enclosure and a diffusion aperture on an internal side of the enclosure, wherein the diffusion aperture is disposed in the relatively reduced pressure region.

8. (Previously presented) The filter apparatus of claim 7 comprising a filter capable of intercepting fluid flowing through the diffusion path.

9. (Previously presented) The filter apparatus of claim 7 wherein the filter chamber defines a permeable enclosure around the diffusion aperture.

10. (Previously presented) The filter apparatus of claim 9 wherein the enclosure supports a filter capable of intercepting the fluid flowing through the diffusion path.

11. (Previously presented) The filter apparatus of claim 9 wherein the enclosure contains a filter capable of intercepting the fluid flowing through the diffusion path.

12. (Previously presented) The filter apparatus of claim 7 wherein the filter chamber adsorbs contaminants flowing into the enclosure via the diffusion path.

13. (Previously presented) A data storage device with a moving data storage medium creating the internal fluid stream that is conditioned by the filter apparatus of claim 12.

14.-19. (Canceled)

20. (Original) A data storage device comprising:

a base deck;

a disc stack assembly secured to the base deck;

an actuator assembly adjacent the disc stack assembly and affixed to the base deck;

a top cover attached to the base deck enclosing the disc stack assembly and the

actuator assembly within a confined environment; and

means for filtering contaminants from the confined environment.

21. (Canceled)

22. (Previously presented) A method comprising:

rotating a data storage medium inside an enclosure to create an internal fluid stream;

diverting a portion of the internal fluid stream through a recirculating filter; and

fluidly mixing the internal fluid stream portion and an external fluid stream with a filter chamber disposed within the internal fluid stream immediately downstream of the recirculating filter.

23. (Previously presented) The method of claim 22 wherein the diverting step is characterized by providing a channel comprising a proximal end in fluid communication with the internal fluid stream and a distal end in fluid communication with a first area of an upstream side of the recirculating filter.

24. (Previously presented) The method of claim 23 wherein the mixing step is characterized by enclosing the recirculating filter with a second area on a downstream side of the recirculating filter in order to induce a pressure drop in the internal fluid stream across the recirculating filter.

25. (Previously presented) The method of claim 24 wherein the mixing step is characterized by filtering the external fluid stream.

26. (Previously presented) The method of claim 25 wherein the diverting and mixing steps are characterized by adsorbing contaminants from the fluid streams.

27. (Previously presented) The method of claim 22 comprising filtering a non-diverted portion of the internal fluid stream.

## **IX. EVIDENCE APPENDIX**

No additional evidence is included.

## **X. RELATED PROCEEDINGS APPENDIX**

There exist no relevant related proceedings concerning this Appeal before the Board.